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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,686	08/24/2000	Gerald Quapil	31833-150836 (RK)	2565

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EXAMINER

PADMANABHAN, KARTIC

ART UNIT PAPER NUMBER

1641

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/643,686

Applicant(s)

QUAPIL ET AL.

Examiner

Kartic Padmanabhan

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1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed with the EPO on 8/24/1999. It is noted, however, that applicant has not filed a certified copy of the EPO 99 116 534.1 application as required by 35 U.S.C. 119(b).

### ***Claim Objections***

2. Claims 17-18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 17 and 18 are drawn to method limitations, which are not interpreted as further limiting a claim drawn to a device.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 is rejected as vague and indefinite because it is unclear if the base recited in line 4 is a part of the vessel it self or of the device as a whole.

6. Claim 7 is rejected as vague and indefinite for the recitation of "adapted" because it has been held that the recitation that an element is "adapted to" perform a function is not a positive

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limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

7. In claim 10, applicant should delete "at" before "the vessel."

8. Claim 19 is rejected as vague and indefinite because applicant has not recited in front of what the filter is installed.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Lekkala et al.

(WO 95/22754). The reference discloses a device for carrying out analysis, comprising an analysis well for receiving the substance to be analyzed. A light source (5), and a detector (6).

The bottom of the reaction space is coated with a layer of material that can generate an SPR signal. The bottom part of the analysis well is transparent to light. The device also comprises a prism boundary surfaces for the emerging light, as well as for total reflection. The light source is directed through the prism towards the reaction space, wherein the detector is arranged such that it receives light from the prism (abstract). The well of the reference has side walls at angles of less than 90 degrees, as seen in the Figures. Further, since the vessel is in the form of a well, it is inherent from the figures that it is a hollow-cylindrical shape with cylindrical bases. The wells of the reference may be in the form of several wells arranged in a row or matrix. The wells can also be arranged in succession in a strip made of plastic in which there are several adjacent wells.

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These strips can be placed side by side to form the structure of a microtiter plate, such that the strips of wells can be inserted into a housing that holds all the strips to create a microtiter plate structure. The bottoms of the strips can have the shape of any of the prisms (page 5, lines 9-21). The well may specifically be made of polystyrene (page 2, lines 24-25). The measurement of the reference is performed such that a polarized light beam is incident through the prism, and light is totally reflected back into the prism at the boundary surface (page 3, lines 12-35). The light source of the reference may be a laser or LED. The device of the reference further comprises collimating optics and focusing optics (page 4, lines 26-36). When strips of wells are used, the device can comprise a row of light sources and a two-dimensional detector of several detectors as the CCD detector (page 6, lines 10-17). The light must be polarized, such that if the light source does not have its own polarizer, one can be placed between the light source and the prism (page 6, lines 25-28). The well plates and strips of the reference can be fabricated by spray molding using plastic material. Further, instead of assembling separate strips, the plate can be made by molding from a single piece (page 7, lines 3-12).

### *Conclusion*

Claims 1-23 are rejected.

References: Zoha et al. and Hart are cited as art of interest for teaching optical devices

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kartic Padmanabhan whose telephone number is 703-305-0509.

The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 703-305-3399. The fax phone numbers for the

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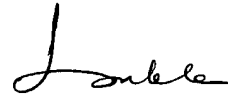
organization where this application or proceeding is assigned are 703-746-5207 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Kartic Padmanabhan  
Patent Examiner  
Art Unit 1641

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January 30, 2003



LONG V. LE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

4/31/03